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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,139	08/03/2000	Ryoichi Imanaka	MAT-3720US4	2101

7590 05/09/2005
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 P O Box 980
 Valley Forge, PA 19482

EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,139

Applicant(s)

IMANAKA, RYOICHI

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 14-22 have been considered but are moot in view of the new ground(s) of rejection.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/2005 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-34 & 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Bush, (U.S. Patent #4,789,863).

Considering amended claim 14, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system, see col. 3, lines 61-68. The additional claimed feature of the provider charging a different amount to the depending upon whether the information is recorded reads on the disclosure of Horton that subscriber's may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the amended claimed feature of the recording information in the medium being effected responsive to the detection of an identifier that identifies the recipient. Nevertheless, Bush discloses a pay per view entertainment system, wherein a subscriber enters a PIN, which must be verified, (i.e., detected and verified), before recording of the content takes place, see col. 4, lines 36-54 & col. 6, lines 11-55. If a negative response is received from the billing service that verifies the requesting subscriber's information, then the recording does take place. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of effecting a recording a recording responsive to the ID of the subscriber being identified, for the desirable advantage of verifying that the

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instant requesting subscriber is authorized to make the purchase, as taught by Bush, see col. 1, lines 58-65.

As for the claimed computer information system, Bush discloses that one of the content that may be delivered over the system includes computer software, col. 2, lines 25-30. Thus the 'computer information system' is at least met by Bush.

Considering claim 15, the claimed transmission means for transmitting information to the recipient is met by the CATV/satellite distribution system, discussed in Horton, (col. 3, lines 61-64).

Considering claim 16, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. The additionally claimed transmission means for transmitting the information to a recipient is met by the CATV or satellite distribution system discussed in Horton, col. 3, lines 61-67.

Considering claim 17, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected.

Considering claim 18, the claimed elements of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected. As for the different feature of receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 19, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. As for the different feature of a recipient for receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 20, the claimed recipient means for receiving information from a provider is met by the CATV/satellite receiver shown in Fig. 1 & col. 3, lines 31-45. The additionally claimed feature of the recipient being charged a different amount depending upon whether recording of the information is effected, is met by Horton, (col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34).

Horton does not teach the further claimed feature of the recording information in the medium being effected responsive to the detection of an identifier that identifies the medium. Nevertheless, Bush discloses a pay per view entertainment system, wherein a subscriber enters a PIN, which must be verified, (i.e., detected and verified), before recording of the content takes place, see col. 4, lines 36-54 & col. 6, lines 11-55. If a negative response is received from the billing service that verifies the requesting subscriber's information, then the recording does take

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place. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of effecting a recording a recording responsive to the ID of the subscriber being identified, for the desirable advantage of verifying that the instant requesting subscriber is authorized to make the purchase, as taught by Bush, see col. 1, lines 58-65.

Considering claim 21, the claimed signal transmitted from a recipient of information to a provider of information, such that the signal indicates whether the information is recorded in a medium, is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 22, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 21, and are likewise rejected.

Considering claims 23-28, the claimed system identifier is broad enough to read on the tag or code which indicates whether a program may be taped or not, Horton, col. 2, lines 31-45. Before taping a program, it is required that this tag or code, which is transmitted from the central office, indicate that taping is authorized.

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Considering claims 29-34, Horton teaches charging a different amount for recording a movie, this amount is charged, whether or not the subscriber actually views the movie, which reads on the claimed subject matter. It is noted that the claims recite that the different amount is charged irrespective of whether the information “is viewed”, which is broader for instance than whether the subscriber is “billed for viewing”.

Considering claim 36, the claimed feature of a ‘transmission means’ is met by the equipment 30 for distributing pre-recorded entertainment, Bush Fig. 4 & col. 3, lines 21-52.

5. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton & Bush, and further in view of Auld, (U.S. Pat # 5,231,665).

Considering claim 35, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system, see col. 3, lines 61-68. The additional claimed feature of the provider charging a different amount to the depending upon whether the information is recorded reads on the disclosure of Horton that subscriber’s may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

The additional claimed feature of ‘recording of information is effective responsive to a detection of an identifier, if the identifier recorded on the medium is an identifier that is

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identifies a registered recording/reproducing apparatus' is not specifically taught by Horton.

Nevertheless, Auld which is in the same field of endeavor discloses detecting whether a *receiver* is authorized to receive content, before the content is received, col. 3, lines 65-67; col. 5, lines 50-68 & col. 6, lines 5-53. Combining Auld with Horton teaches one of ordinary skill in the art, to require authorization of the receiver before recording takes place, which reads on the claim. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton, with the feature of verifying the authorization of a terminal before a video signal is received, for the benefit of ensuring only authorized terminals receive the content, as taught by Auld, col. 2, lines 5-56.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A Kauffman Teaches requiring a descrambling key before viewing selected video content.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
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or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 746-6861 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")


Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290.

The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the
organization where this application or proceeding is assigned is (703) 872-9306 for regular
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown


REUBEN M. BROWN
PATENT EXAMINER